

## REMARKS

## Status of the Claims

Claims 1-21 are pending in the present application. Claims 1, 8, 9, 10, 13, 14, and 15 have been amended to more clearly define the invention.

## Telephone Conference with the Examiner

On January 30, 2003, applicants' attorney, conducted a telephone interview with the Examiner and his Supervisory Examiner in which the cited art was discussed. In particular, applicants' attorney requested that the Examiner identify with specificity those elements disclosed in the cited art that the Examiner felt were equivalent to elements recited in applicants' claims, in order to facilitate the preparation of an appropriate response to the rejection of applicants' claims. The Examiner's position is that the advertising content disclosed by Brown is equivalent to the recited items in applicants' claims, and that the priority queues disclosed by Brown are equivalent to the item slot groups recited by applicants. The Examiner further indicated that he believes queues inherently define a finite number of empty slots, in that from a programming standpoint, when a queue is constructed, a predefined amount of memory resources must be allocated to the queue, so that the number of slots in a queue will generally be predetermined.

Applicants' attorney wishes to thank the Examiner and his Supervisor for explaining the Examiner's position in greater detail.

## MPEP 706 and the Articulation of Rejections

As the telephone interview above notes, the present application was finally rejected before the Examiner had explained to applicant how a queue could be considered to be equivalent to a group of item slots. While in the first Office Action the Examiner did assert that queues were equivalent to item slot groups, and provided a reference to the cited art that disclosed queues, the Examiner did not articulate why queues could be considered equivalent. The articulation that *from a programming standpoint, when a queue is constructed, a predefined amount of memory resources must be allocated to the queue, so that the number of slots in a queue will generally be predetermined* was only provided in the context of the above noted telephone interview.

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1           While citing to a specific portion of a reference is quite helpful, such citations, absent a  
2 clear articulation of the Examiner's reasoning, often provide insufficient detail to an applicant to  
3 enable a satisfactory response to be prepared.

4           The MPEP recognizes this, and MPEP 706 notes that "*The goal of examination is to*  
5 *clearly articulate any rejection early in the prosecution process so that the applicant has the*  
6 *opportunity to provide evidence of patentability and otherwise reply completely at the earliest*  
7 *opportunity.*" MPEP 706 also notes that "[*T*]he pertinence of each reference, if not apparent,  
8 must be clearly explained and each rejected claim specified." While the Examiner certainly  
9 understood how he interpreted the relevance of the cited portions of the reference, the lack of  
10 articulation of the Examiner's thought processes in making his rejection did not enable applicants  
11 to properly reply prior to the Final Office Action.

12           Indeed, even after the above noted telephone interview, and the advisory action dated  
13 May 23, 2003, it is still not clear what element disclosed in the cited art is equivalent to the meta  
14 item slot groups recited in Claims 8 and 13. The advisory action states "queues can be combined  
15 to form a main queue (col 17, lines 30-55; col 5, lines 40-49; col 3, line 62-col 4, line 15)." The  
16 term "main queue" or "meta slot item group" is not employed in any of those citations. With no  
17 additional articulation, it is very difficult to understand the Examiner's logic. While the  
18 Examiner's position may be entirely correct, without sufficient articulation of the reasoning that  
19 leads to a conclusion, applicants are poorly equipped to prepare either arguments or amendments  
20 to respond to such a rejection.

21           Applicants respectfully request that any future rejections include a concise articulation of  
22 the Examiner's logic. Providing specific citations to a reference is enormously helpful, and  
23 applicants desire the Examiner to continue to provide such citations. In addition, a brief  
24 articulation of what it is about that specific citation is particularly relevant is very helpful. While  
25 that relevance may be very clear to the Examiner, it is not always so clear to the applicant. For  
26 example, until the Examiner described in the telephone interview why, from a programming  
27 standpoint, a queue was equivalent to an item slot group, the relevance was not clear to  
28 applicants.

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1           Claims Rejected under 35 U.S.C. § 102

2           The Examiner has rejected Claims 8 and 13 under 35 U.S.C. § 102(e) as being anticipated  
3           as by Brown (U.S. Patent No. 6,026,368). Applicants have significantly amended Claims 8 and  
4           13, rendering the rejection moot. Claims 8 and 13 as amended distinguish over the cited art for  
5           the following reasons.

6           Both Claim 8 and 13 have been amended to make it clear that each item slot represents a  
7           “space” available in some inventory of available spaces. In the context of the preferred  
8           embodiments, the spaces are locations on web pages where ad content can be inserted. The  
9           specification notes that the spaces can also represent other empty spaces that can be filled with  
10          items. The preambles have been amended to make it clear the method relates to filling the empty  
11          item slots in an inventory. The additional step of determining the number of empty slots in  
12          inventory has been added to each claim. While Brown (6,026,368) discloses a method for  
13          providing online ads for available spaces for ads, the specific steps employed by Brown are not  
14          the same as those recited in the claims in the present application.

15          The step of constructing item slots has been amended to recite organizing the empty slots  
16          into slot item groups, based on the types of items that can be used to fill the item slots. Each  
17          different slot group represents item slots that can be filled with related items. The priority  
18          queues described by Brown are constructed programmatically, and there is no disclosure and no  
19          basis to conclude that such queues are constructed to have different sizes, or that the size of a  
20          queue directly corresponds to empty spaces in an inventory. Logically, each queue disclosed by  
21          Brown has been programmatically constructed to be a predefined size. Each item slot group can  
22          be a different size, based on a particular inventory of item slots (i.e. spaces).

23          The claims next recite that meta item slot groups are constructed, one meta item slot  
24          group for each meta characteristic expressed by items that can be used to fill specific item slots.  
25          Note that two different item slot groups may include item slots that can be filled by items having  
26          the same meta characteristic, and thus a meta item slot group is formed to have the same number  
27          of meta item slots as there are item slots in those item slot groups. Note that the Examiner has  
28          referred to Brown disclosing a “main” queue. While this reference is not fully understood, it  
29          appears that the Examiner is referring to the generation of a play list based on subscriber queues,  
30          location queues and time period queues. Not only are queues not equivalent to item slot groups

1 (as amended), but the play list generated based on such queues does not contain each item  
2 present in those queues. Note Brown specifically discloses (col 17, lines 46-50) that some  
3 elements in those queues will not be included in the play list. Also, if the play list is considered  
4 to be a programmatically generate queue (i.e. inherently defines a finite number of empty slots),  
5 logically the play list queue is the same size as each of the subscriber queues, location queues  
6 and time period queues. Applicants' claims recite that the meta item slot groups include the  
7 same number of item slots as are included in each related item slot group. Thus if item slot  
8 group A includes 15 item slots, and item slot group B contains 12 item slots, and each item slot  
9 in item slot groups A and B can be filled by an item with the same meta characteristic, then a  
10 meta item slot group will be constructed that includes 17 meta item slots (12+15). That is not  
11 identical to what is described by Brown, nor is there any suggestion in the cited art to modify  
12 brown to achieve all that is claimed.

13 The process of filling the constructed item slots in the item slot groups and meta item  
14 slots in the meta item slot groups also are not disclosed by Brown. Note because the meta item  
15 slot groups are based on the item slot groups, there is a 1:1 correlation between the meta item  
16 slots and the item slots. The meta item slot groups are filled first with items of a first type, which  
17 exhibit meta characteristics. Then unfilled meta item slots are filled by items of the second type,  
18 which exhibit meta and group characteristics (i.e. broad and narrow characteristics). This  
19 determines how many items of the second type are needed. Only then will the item slots be  
20 filled. Now, the item slots are filled by the items of the second type, by matching the group  
21 (narrow) characteristics to item slots in item slot groups organized based on the same group  
22 characteristic. Then the same number of items of the first type are used to fill the remaining item  
23 slots, based on meta characteristics of the items of the first type. Brown does not appear to  
24 disclose the meta and group characteristics recited, and more importantly, Brown does not  
25 disclose the specific sequence of steps recited, as outlined above.

26 The Examiner has repeatedly cited to portions of Brown's disclosure that refer to folders  
27 and groups (column 9, lines 34-52). Applicants do not understand what relevance the Examiner  
28 attaches to that portion of Brown. Applicants respectfully request that if the Examiner believes  
29 that such folders and groups are relevant, that the Examiner provide an articulation of how those  
30 elements relate to the elements recited in applicants' claims.

1       Further, the Examiner consistently cites to a portion of Brown's disclosure (col 13,  
2 lines 19-26) that states that an analyst creates and controls all aspects of targeting objects. Again,  
3 it is not clear how that is relevant to specific steps recited in applicants' claims. That statement  
4 alone is insufficient to conclude that Brown teaches *all* possible methods to fill an empty space  
5 with content. Applicant respectfully requests additional articulation relating to the Examiner's  
6 understanding of the relevance of this portion of the reference.

7       The cited art does not teach or suggest the specific sequence of steps recited in Claims 8  
8 and 13 as amended. Accordingly, the rejection of Claims 8 and 13 under 35 U.S.C. § 102(e) as  
9 being anticipated as by Brown (U.S. Patent No. 6,026,368) should be withdrawn.

10 Rejections Based on 35 U.S.C. § 103

11       The Examiner has rejected Claims 1-7, 9-12, and 14-17 under 35 U.S.C. § 103(a) as  
12 being unpatentable over Brown (U.S. Patent No. 6,026,368), in view of Hoyle (U.S. Patent  
13 No. 6,141,010). The Examiner indicates that Brown discloses an invention equivalent to that  
14 defined by applicants' claims, except for displaying information in a bar graph format. The  
15 Examiner relies on Hoyle for teaching complex graphical displays and argues that it would have  
16 been obvious to combine Hoyle's graphics with Brown's advertising method to achieve the  
17 present claimed invention. Applicants have significantly amended Claim 1, rendering the  
18 rejection moot. Claim 1 as amended distinguishes over the cited art for the following reasons.

19       As with claim 8 and 13, Claim 1 has been amended to make it clear that each item slot  
20 represents a "space" available in some inventory of available spaces, and to add the step of  
21 determining the number of empty slots in inventory. The step of constructing item slots has been  
22 amended to recite organizing the empty slots into slot item groups, based on the types of items  
23 that can be used to fill the item slots. Thus each different slot group has a specific size related to  
24 the item slots that can be filled with related items. As discussed above, such item slot groups are  
25 distinguishable from the priority queues described by Brown, which are constructed  
26 programmatically to be the same size.

27       Applicants respectfully submit that Brown does not teach an equivalent method for filling  
28 item slots, and thus even if the suggested combination were made, the resulting combination  
29 would not be equivalent to the invention recited in applicants' Claim 1.

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1       Further, applicants have noted that Holye does not disclose the recited histograms.  
2 Merely because Hoyle discloses that information relating to banner ads can be provided as  
3 visually-perceived data, the cited art does not teach or suggest the use of histograms. The  
4 Examiner has provided no articulation as to why a disclosure of one type of graphical display  
5 renders the use of a histogram as obvious. The cited art does not appear to suggest the use of  
6 histograms, and absent such a suggestion, a *prima facie* case of obviousness is not supported.

7       It should be noted that the above discussion is directed to the patentability of  
8 independent Claim 1. Independent Claims 8 and 13 are patentable for the reasons discussed  
9 above. In the interest of simplifying this response, applicants have elected not to specifically  
10 explain why each of the dependent claims are also patentable over the prior art of record, but this  
11 decision should not be construed as an indication that the dependent claims do not recite  
12 patentable subject matter. Indeed, applicants believe that each dependent claim also recites  
13 patentable subject matter. In any case, each dependent claim is patentable for at least the same  
14 reasons as the independent claim on which it ultimately depends. Accordingly, the rejection of  
15 Claims 1-7, 9-12, and 14-17 under 35 U.S.C. § 103 as being unpatentable over Brown in view of  
16 Hoyle should be withdrawn.

17 Patentability of Newly added Claims 18-21

18       Claim 18 is based on Claim 8, and adds additional detail. Claim 18 is patentable for the  
19 same reasons as Claim 8, which is discussed in detail above.

20       Claim 19 is based on Claim 13, and also adds additional detail. Claim 19 is patentable  
21 for the same reasons as Claim 13.

22       Claim 20 is similar to Claim 8, and represents an attempt to define the same concepts in a  
23 more natural language. Claim 20 is patentable for the same reasons as Claim 8.

24       Claim 21 is based on Claim 8, before the present amendments. While applicant  
25 understands why the Examiner believes that the item slot groups of Claim 21 can be considered  
26 as equivalent to Brown's priority queues, it is not clear what element disclosed by Brown is  
27 equivalent of the meta item slot groups of Claim 21. As noted above, the Examiner stated in the  
28 Advisory Action (May 23, 2003) that Brown discloses a main queue. However, the meta item  
29 slot group recited in Claim 21 must include, by definition, a meta item slot for each item slot in  
30 each item slot group related to that meta item slot group. The play list described by Brown does

1 not include each element from the subscriber, location and time period queues. Also, if the  
2 Examiner asserts on the one hand that all queues are programmatically defined to have a specific  
3 number of empty "slots" that can be filled, then logically the main queues (the play list?) must be  
4 the same size (have the same number of slots) as each of the subscriber, location and time period  
5 queues. As defined in Claim 21, a meta item slot group related to two item slot groups must be  
6 larger (have more meta item slots) than each item slot group. Indeed, such a meta item slot  
7 group includes a meta item slot for each item slot in the related item slot groups. This is not  
8 equivalent to the queues disclosed by Brown.

9 In consideration the Remarks set forth above, it is submitted that all claims in the  
10 application define a novel and non-obvious invention and are thus patentable. The Examiner is  
11 therefore requested to pass this case to issue without delay. Should any further questions remain,  
12 the Examiner is invited to telephone applicants' attorney at the number listed below.

13  
14 Respectfully submitted,

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18 Ronald M. Anderson  
19 Registration No. 28,829

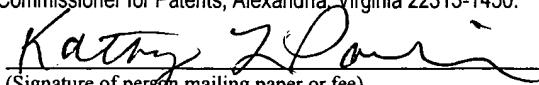
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